



UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Ch

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/424,498 02/15/00 SCHWARZ

H BHV-314.01

HM12/0622
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER
8TH FLOOR
SAN FRANCISCO CA 94111-3834

EXAMINER

SCHNIZER, H

ART UNIT

PAPER NUMBER

1653

DATE MAILED:

06/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

FILE COPY

Office Action Summary

Application No.
09/424,498

Applicant(s)

Schwarz et al.

Examiner

Holly Schnizer

Art Unit

1653

The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 8, 2001
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 31-63

4a) Of the above, claim(s) _____ is/are pending in the application

5) ☐ Claim(s) _____ is/are withdrawn from consideration

6) ☐ Claim(s) _____ is/are allowed.

7) ☐ Claim(s) _____ is/are rejected.

8) ☒ Claims 31-63 _____ is/are objected to.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____

- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

Office Action Summary

Part of Paper No 8

Art Unit: 1653

DETAILED ACTION

Status of the Claims

1. The Preliminary Amendment filed February 15, 2000 (Paper No. 5) has been entered. Claims 1-30 have been canceled and Claims 31-63 have been added.

Election/Restriction

2. This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.
3. In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 31-44, drawn to a pharmaceutical preparation comprising a von Willebrand (vWF) propeptide.

Group II, claims 45-55, drawn to a method of producing the pharmaceutical preparation containing vWF propeptide.

Group III, claims 56-58, drawn to a method of treating a patient at risk of a blood coagulation disorder.

Group IV, claims 59-63, drawn to a method of improving the compatibility of vWF preparations administered to patients.

Art Unit: 1653

2. The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

4. The technical feature linking Groups I-IV appears to be that they all relate to a pharmaceutical preparation containing vWF propeptide. However, vWF propeptide compositions patentably indistinguishable from the claimed compositions were known in the art at the time of the invention (for example, see Takagi et al. J. Biol. Chem. (1989) 264(11): 6017-6020 and Fujisawa et al. Eur. J. Biochem. (1991) 196(3): 673-677). Therefore, the technical feature linking the inventions of Groups I-IV does not constitute a special technical feature as it does not define a contribution over the prior art.

9. The special technical feature of Group I is a pharmaceutical composition comprising a vWF propeptide.

10. The special technical feature of Group II is a method of producing a pharmaceutical composition containing a vWF propeptide.

11. The special technical feature of Group III is a method of treatment using a composition containing a vWF propeptide.

5. The special technical feature of Group IV is a method of improving the compatibility of vWF preparations that are administered to patients.

Art Unit: 1653

12. Accordingly, Groups I-IV are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

13. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

14. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Holly Schnizer whose telephone number is (703) 305-3722. The examiner can normally be reached Monday and Thursday from 8 am to 5:30 pm and Tuesday and Wednesday from 9 am to 2:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached at (703) 306-4119. The fax phone number for Official Papers to this Group is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Holly Schnizer, Ph.D.
June 18, 2001



KAREN COCHRANE CARLSON, PH.D.
PRIMARY EXAMINER